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10/727,442	12/03/2003	Barrington Herman	WEYE121980/24877	7117

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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/727,442
Filing Date: December 03, 2003
Appellant(s): HERMAN, BARRINGTON

*Teresa J. Wiant
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 14 November 2005 appealing from the Office action mailed 17 May 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: None

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Cuenca et al. "In vitro adventitious bud regeneration from internode segments of beech" Plant cell, tissue, and organ culture, vol. 60 no. 3 (2000) pages 213-220

Saul et al. "Vegetative Propagation of Alder (Alnus glutinosa L.) by Rooted Cuttings" Forest Research Note, no. 33, Ministry of Natural Resources, Ontario, Canada, (1982), pages 1-4

Bryan et al. "Accelerating Fraser Fir seedling growth with benzylaminopurine" HortScience vol. 26, no. 4 (1991) pages 389-390

Wang "Growth substance, light, fertilizer, and misting regulate propagation and growth of golden pothos" HortScience vol. 25, no. 12 (1990) pages 1602-1604

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 7, and 8 stand rejected as being unpatentable under 35 U.S.C. 103(a) over Cuenca et al., Plant Cell, Tissue and Organ Culture 6::213-220 (2000), in view of Saul et al., Forest Research Note 33, Ministry of Natural Resources, Ontario, Canada. 1982.

Claims 2-6, 9, 10, and 13 stand rejected as being unpatentable under 35 U.S.C. 103(a) over Cuenca et al. in view of Saul et al., and further in view of Bryan et al., Hortscience 26ï4):389-390, 1991.

Claims 11 and 12 stand rejected as being unpatentable under 35 U.S.C. 03(a) over Cuenca et al. in view of Saul et al., and further in view of Bryan et al. and further in view of applicant's Specification.

Claim 14 stands rejected as being unpatentable under 35 U.S.C. 103(a) over Cuenca et al., in view of Saul et al., and further in view of Wang. Hortscience 25(12):1602-1604, 1990. 24877

(10) Response to Argument

As to claims 1,7, and 8 - the first ground of rejection, Applicant's arguments are: (1) no motivation to modify the *in vitro* method of Cuenca et al. that uses internode tissue so that the method is used with a log (Brief page 11, lines 9-12); (2) Cuenca et al. teaches away from the present invention because Cuenca et al. discloses that it is well known in the art that bud regeneration from explant material from beech is unsuccessful (Brief page 11, lines 12-14); (3)

even though Cuenca et al. state that their goal is to ""use adult material"" to produce shoots there is no expectation of success to modify Cuenca et al. to be used with logs (Brief page 11, 21-23); and (4) Saul et al. does not teach or suggest the method of applying cytokinin to a log and there is no motivation to apply Cuenca et al. with Saul et al.

As to arguments (1), (3), and (4), Examiner considers there to be explicit motivation in Cuenca et al. to modify the method of Cuenca et al. to obtain "bud regeneration form adult material in the field" because Cuenca et al. explicitly discloses this desire or motivation at page 214, col. 1. Cuenca et al. discloses the use of BA in the production of buds from juvenile material. Therefore, it would be obvious for one of ordinary skill in the art to try to generate shoots from logs, *i.e.*, adult material in the field, with cytokinin since Cuenca et al. disclosed it use with juvenile material. However, for a proper rejection under 35 USC 103(a) there must be reasonable expectation of success (see MPEP 2143.02). Saul et al. provides the reasonable expectation of success because it discloses that both lignified cutting (considered logs) and green cuttings (considered juvenile material) both produced roots when cloned (see "Conclusion" of Saul et al. at page 2). Therefore, one of ordinary skill in the art of plant tissue culture, knowing the work of Saul et al. discloses that both cuttings of logs and juvenile material can generate roots when cultured, would conclude there is a reasonable expectation of success of generating shoots from logs with the use of cytokinin since Cuenca et al. discloses the success of cytokinin in generating shoots from juvenile material.

As to argument (2), Examiner considers the language of page 214, col. 1, of Cuenca et al. to disclose the poor success of regeneration when leaf explants were used. Cuenca et al. then

states at page 214, col. 1, that there work would use other types of plant material. They found juvenile material to generate shoots (see abstract of Cuenca et al.).

As to claim 14 - the fourth ground of rejection, Applicant's argument is that Wang teaches away from the present invention because Wang discloses the use of higher levels of fertilizer than the levels used by Applicant (Brief page 15, last para.).

As to Applicant's argument, Examiner considers it obvious to one of ordinary skill in the art that nitrogen fertilizer affects plant growth. Wang discloses that nitrogen fertilizer affects plant growth when the plants are cuttings (consider by Examiner to be equivalent to shoots) in a cloning process using cytokinin. One of ordinary skill would look to Wang to see that application of fertilizer affects the growth of shoots in tissue culture methods. Therefore, one of ordinary skill in the art would be motivated to use nitrogen fertilizer in the method of Cuenca et al. and Saul et al. and to optimize the amount of fertilizer used.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jeffrey L. Gellner

Conferees:

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Robert Swiatek RPS